

REMARKS:

Claims 2-11, 13-19, and 21-42 are currently pending in the application. Claims 28 and 35 stand rejected under 35 U.S.C. § 101. Claims 2-4, 6, 8-11, 13-15, 19, 21-23, 25, and 27-42 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,732,161 to Hess et al. ("*Hess*") in view of U.S. Publication No. 2003/0050958 to Keller, et al. ("*Keller*"). Claims 5, 7, 9, 16, 18, 24, and 26 stand rejected under 35 U.S.C. § 103(a) over *Hess* in view of *Keller* and in further view of U.S. Patent No. 6,091,835 to Smithies, et al. ("*Smithies*").

Although the Applicant believes that claims 2-11, 13-19, and 21-42 are directed to patentable subject matter and are in condition for allowance without amendment. The Applicant has amended independent claims 28 and 35 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully denies any statement or averment of the Examiner not specifically addressed. Particularly, the Applicant reserves the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed claims 1-42. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

Claims 28 and 35 stand rejected under 35 U.S.C. § 101 as allegedly being inoperative. Specifically, the Examiner states that claims 28 and 35 "lack utility [] without specifying what methods or systems to implement." (20 October 2005 Office Action, Page 2). The Applicant respectfully disagrees.

Nonetheless, the Applicant has amended independent claims 28 and 35 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to

the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action.

The Applicant respectfully submits that amended independent claims 28 and 35 are considered to be in full compliance with the requirements of 35 U.S.C. § 101. The Applicant further submits that amended independent claims 28 and 35 are in condition for allowance.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 2-4, 6, 8-11, 13-15, 19, 21-23, 25, and 27-42 stand rejected under 35 U.S.C. § 103(a) over *Hess* in view of *Keller*. Claims 5, 7, 9, 16, 18, 24, and 26 stand rejected under 35 U.S.C. § 103(a) over *Hess* in view of *Keller* and in further view of *Smithies*.

Although the Applicant believes independent claims 2-11, 13-19, and 21-42 are directed to patentable subject matter and are in condition for allowance without amendment. The Applicant has amended independent claims 28 and 35 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that *Hess* or *Keller* either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2-4, 6, 8-11, 13-15, 19, 21-23, 25, and 27-42. The Applicant further submits that *Hess* or *Smithies* either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 5, 7, 9, 16, 18, 24, and 26. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of claims 2-11, 13-19, and 21-42 under 35 U.S.C. § 103(a) over the proposed combination of *Hess*, *Keller*, and *Smithies*, either individually or in combination.

The Proposed *Hess-Keller* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant Claims

For example, with respect to independent claim 30, this claim recites:

An ***electronic commerce system for third party document reuse of transaction documents***, the system comprising:

one or more ***document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document*** and at least portions of each transaction document ***capable of being used to facilitate a transaction with one or more of the parties to the transaction document***,

a ***global content directory including a plurality of classes*** organized in a hierarchy, each class categorizing the transaction documents and associated with one or more attributes of the transaction documents categorized in the class, ***at least one of the classes having one or more associated pointers that identify one or more document repositories***;

an intelligence module operable to, in response to selection of a transaction document ***by a party who was not a party to the past transaction*** associated with the transaction document, ***create a generic document*** capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document repositories, ***encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document***, and

a search interface operable to communicate a search query for transaction documents to one or more document repositories identified by one or more pointers associated with one or more selected classes.
(Emphasis Added).

Independent claims 28, 35, and 42 recite similar limitations. *Hess* or *Keller* either individually or in combination, fail to disclose, teach, or suggest each and every element of independent claims 28, 30, 35, and 42.

The Applicant respectfully submits that *Hess* has nothing to do with independent claim 30 limitations regarding an “***electronic commerce system for third party document reuse of transaction documents***”. In particular, the Examiner equates an “***electronic commerce system for third party document reuse of transaction documents***” recited in independent claim 30 with the “on-line system for person to person trading where user’s item images are harvested, stored and made available for users for a

defined duration” purportedly disclosed in *Hess*. (20 October 2005 Office Action, Page 3). The Applicant respectfully disagrees. In fact, the on-line system for person to person trading in *Hess* is “facilitated by providing **prospective buyers the ability to quickly preview [images of] items for sale**”. (Column 2, Lines 5-15). In contrast, the “**electronic commerce system**” recited in independent claim 30 is provided for “**third party document reuse of transaction documents**”. *Hess* cannot provide an “**electronic commerce system for third party document reuse of transaction documents**”, since *Hess* does not teach, suggest, or even hint at anything more than a passive non-transactional quick preview of **images of items for sale**, that have **not been** the subject of a transaction or **not likely to have been** the subject of a transaction by the prospective buyer or any other persons associated with the on-line trading system. Thus, the Applicant respectfully submits that the equations forming the foundation of **the Examiner’s comparison between Hess and independent claim 30 cannot be made**. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent claim 30 from *Hess*.

The Applicant further submits that *Hess* has nothing to do with independent claim 30 limitations regarding “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document** and at least portions of each transaction document **capable of being used to facilitate a transaction with one or more of the parties to the transaction document**”. In particular, the Examiner equates “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document**” recited in independent claim 30 with the “user items for sale are retrieved from repository and populated into web pages for serving as a trading document” purportedly disclosed in *Hess*. (20 October 2005 Office Action, Page 3). The Applicant respectfully disagrees. In fact, the user items for sale in *Hess* are provided for presenting the items in a predefined page format and have nothing to do with a past transaction or even a past item of the user in *Hess*. (Column 8, Line 62 through Column 8, Line 46). In contrast, the “one or more **document repositories storing a plurality of transaction documents**” recited in independent claim 30 are “**each associated with a past transaction of a party to the transaction document**”. *Hess*

cannot provide “one or more **document repositories storing a plurality of transaction documents**”, since *Hess* does not teach, suggest, or even hint at each of the plurality of transaction documents “**associated with a past transaction of a party to the transaction document**”, in the first place. Thus, the Applicant respectfully submits that the equations forming the foundation of ***the Examiner’s comparison between Hess and independent claim 30 cannot be made***. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent claim 30 from *Hess*.

The Applicant yet further submits that the Office Action acknowledges, and the Applicant agrees, that *Hess* fails to disclose the emphasized limitations noted above in independent claim 30. Specifically the Examiner acknowledges that *Hess* fails to disclose the “**transaction documents, each associated with a past transaction of a party to the transaction document**.” (20 October 2005 Office Action, Page 4). However, the Examiner asserts that the cited portions of *Keller* disclose the acknowledged shortcomings in *Hess*. The Applicant respectfully traverses the Examiner’s assertions regarding the subject matter disclosed in *Keller*.

The Applicant respectfully submits that *Keller* has nothing to do with independent claim 30 limitations regarding an “**electronic commerce system for third party document reuse of transaction documents**” and in particular *Keller* has nothing to do with independent claim 30 limitations regarding “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document** and at least portions of each transaction document **capable of being used to facilitate a transaction with one or more of the parties to the transaction document**”. In particular, the Examiner equates the “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document**” recited in independent claim 30 with “the transaction log records each transaction conducted, including ordered and acknowledged items” purportedly disclosed in *Keller*. (20 October 2005 Office Action, Page 4). The Applicant respectfully disagrees. In fact, the transaction log records in *Keller* are a table that stores information that can later be accessed by

retailers and has nothing to do with a past transaction of a party to the transaction document, but merely allows retailers (whether or not they are a party to the transaction) access to the information. (Page 4, Paragraphs 0042 and 0043). In contrast, the “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document**”, recited in independent claim 30 is a transactional document, not a transaction log table, that is associated with a past transaction of a party to the transaction document. *Keller* cannot provide “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document**”, since *Keller* does not teach, suggest, or even hint at a party associated with, or even a retailer associated with, a past transaction, in the first place. Thus, the Applicant respectfully submits that the equations forming the foundation of ***the Examiner’s comparison of the combination of Hess and Keller to independent claim 30, of the subject Application, cannot be made.*** The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent claim 30 from *Hess and Keller*.

The Applicant still further submits that *Hess* or *Keller* have nothing to do with independent claim 30 limitations regarding: “a **global content directory including a plurality of classes** organized in a hierarchy, each class categorizing the transaction documents and associated with one or more attributes of the transaction documents categorized in the class, **at least one of the classes having one or more associated pointers that identify one or more document repositories;**” “an **intelligence module operable to**, in response to selection of a transaction document **by a party who was not a party to the past transaction** associated with the transaction document, **create a generic document** capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document repositories, **encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document;**” or “a **search interface** operable to communicate a search query for transaction documents to one or more document

repositories identified by one or more pointers associated with one or more selected classes.”

Although *Keller* may disclose a manufacturer’s ability to download its own database and protect data by security techniques so that there is little risk of unauthorized disclosure of one manufacturer’s information to another manufacturer”. (Page 2, Paragraph 0015). *Keller* does not disclose “***an intelligence module operable to***, in response to selection of a transaction document ***by a party who was not a party to the past transaction*** associated with the transaction document, ***create a generic document*** capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document repositories, ***encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document***”. It appears that the Examiner is purporting to establish that the security techniques in *Keller* are some how related to ***creating a generic document*** capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document repositories, and ***encrypting at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document***, in the subject Application.

However, it is not clear how the security techniques in *Keller* are purportedly based or analogous to ***encrypting at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document***, in the subject application. ***Even assuming for the sake of argument that the security techniques in Keller are some how analogous to the encrypting in the subject application, which they are not, in fact they are clearly not***, there is still no disclosure, teaching, or suggestion in *Keller* that there is “***an intelligence module operable to***, in response to selection of a transaction document ***by a party who was not a party to the past transaction*** associated with the transaction document, ***create a generic document*** capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document

repositories, ***encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document***".

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Hess* and *Keller*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Hess* and *Keller* as proposed. The Office Action merely states that "it would have been obvious to one having ordinary skill in the art at the time of the [A]pplicant's invention was made to combine Keller's teaching with Hess". (20 October 2005 Office Action, Page 4). The Applicant respectfully disagrees.

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Hess* or *Keller*, either individually or in combination. In essence, the Examiner asserts that one of ordinary skill in the art at the time of the invention would have been motivated "because both references are devoted to e-commerce and transaction document processing and, the combined teaching of the two references would have provided a mechanism for users of Hess' system to enhance on-line trading by quicker previewing items via an on-line facility which provides user of a supplier information about the status of the transactions involving the products of the supplier." (20 October 2005 Office Action, Page 4). The Applicant respectfully disagrees. ***The Applicant respectfully request the Examiner to point to the portions of Hess or Keller which contain the teaching, suggestion, or motivation to combine Hess or Keller for the Examiner's stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based***

upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, **the Examiner has not adequately supported the selection and combination of Hess or Keller to render obvious the Applicant's claimed invention.** The Examiner's conclusory statements that "it would have been obvious to one having ordinary skill in the art at the time of the [A]pplicant's invention was made to combine Keller's teaching with Hess reference" and "because both references are devoted to e-commerce and transaction document processing", **does not adequately address the issue of motivation to combine.** (20 October 2005 Office Action, Page 4). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of Hess or Keller, either individually or in combination.

The Proposed Hess-Keller-Smithies Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 5, 7, 16, 18, 24, and 26

The Applicant respectfully submits that Hess, Keller, or Smithies, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent claims 5, 7, 16, 18, 24, and 26. Thus, the Applicant respectfully traverse the Examiner's obvious rejection of dependent claims 5, 7, 16, 18, 24, and 26 under 35 U.S.C. § 103(a) over the proposed combination of Hess, Keller, and Smithies, either individually or in combination.

For example, with respect to dependent claim 5, this claim recites:

The system of Claim 30, wherein **the intelligence module:**
segments the selected transaction document into one or more
sections;

determines which sections of the selected transaction document are generic and which sections are specific to the past transaction; and
removes from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction; and
carries forward the generic sections from the selected transaction document into the generic document to protect one or more confidential details in the selected transaction document. (Emphasis Added).

Dependent claims 16 and 24 recite similar limitations. *Hess, Keller, or Smithies*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 5, 16, and 24.

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Hess* and *Keller* fail to disclose the emphasized limitations noted above in dependent claim 5. Specifically the Examiner acknowledges that *Hess* and *Keller* fails to teach "***removes from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction***". (20 October 2005 Office Action, Page 12). However, the Examiner asserts that the cited portions of *Smithies* disclose the acknowledged shortcomings in *Hess* and *Keller*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Smithies*.

The Applicant further submits that *Smithies* has nothing to do with dependent claim 5 limitations regarding "***remove[ing] from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction***". Rather *Smithies* discloses a system for providing a transcript of a single party during a voluntary statement memorializing circumstances which may help the party remember the circumstances in the future. (Abstract and Column 13, Lines 32-41). *Smithies* merely discloses this system for providing a transcript to help a single party remember circumstances in the future and does not teach, suggest, or even hint at "***remove[ing] from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to***

facilitate the future transaction". Thus, *Smithies* cannot provide "**remove[ing] from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction**", since *Smithies* does not even provide **a past transactional document**, a past transcript or even any other type of past document stored in a document repository that provides for selected information to be made inaccessible in a created generic document.

The Applicant further submits that the Office Action acknowledges, and the Applicant agrees, that *Keller* and *Smithies* fail to disclose the limitations in dependent claims 7, 18, and 26. Specifically the Examiner acknowledges that *Keller* and *Smithies* fail to teach **the intelligence module is further operable to dynamically adjust the information in the sections in the generic document to include current information**. (20 October 2005 Office Action, Page 13). However, the Examiner asserts that the cited portions of *Hess* disclose the acknowledged shortcomings in *Keller* and *Smithies*. The Applicant respectfully disagrees. In particular, the Examiner equates "**the intelligence module is further operable to dynamically adjust the information in the sections in the generic document to include current information**" recited in dependent claims 7, 18, and 26 with a "harvesting process [that] periodically reloads images and updates thumbnails" purportedly disclosed in *Hess*. (20 October 2005 Office Action, Page 13). The Applicant respectfully disagrees. In fact, the harvesting process in *Hess* "downloads user-specified images associated with newly listed items to its local database". (Column 6, Lines 31-42). In contrast, the "**intelligence module**" recited in dependent claims 7, 18, and 26 "**dynamically adjust[s] the information in the sections in the generic document to include current information**". *Hess* cannot provide an "**intelligence module**" that "**dynamically adjust[s] the information in the sections in the generic document to include current information**", since *Hess* does not teach, suggest, or even hint at anything more than a passive download process of images associated with newly listed items. Thus, the Applicant respectfully submits that the equations forming the foundation of **the Examiner's comparison between Hess and dependent claims 7, 18, and 26 cannot be made**. The Applicant further respectfully submits that these

distinctions alone are sufficient to patentably distinguish dependent claims 7, 18, and 26 from *Hess*, *Keller*, and *Smithies*.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Hess*, *Keller*, or *Smithies*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Hess*, *Keller*, and *Smithies* as proposed. The Office Action merely states that “it would have been obvious to one having ordinary skill in the art at the time of the [A]pplicant’s invention was made to combine *Smithies*’ teaching with *Keller* and *Hess*”. (20 October 2005 Office Action, Page 12). The Applicant respectfully disagrees.

The Applicant further submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Hess*, *Keller*, or *Smithies*, either individually or in combination. In essence, the Examiner asserts that one of ordinary skill in the art at the time of the invention would have been motivated “because the references are devoted to e-commerce and transaction document processing where *Hess* provides a generic system while *Smithies* teaches transcribing electronic affirmations, and the combined reference would have further enhanced *Hess* system’s functionality by the implementation of flexibility updating e-commerce trading transaction document.” (7 October 2005 Office Action, Page 9). The Applicant respectfully disagrees. ***The Applicant respectfully requests the Examiner to point to the portions of Hess, Keller, or Smithies, which contain the teaching, suggestion, or motivation to combine Hess, Keller, or Smithies for the Examiner’s stated purported advantage.*** The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based***

upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of Hess, Keller, or Smithies to render obvious the Applicant's claimed invention.*** The Examiner's conclusory statements that "it would have been obvious to one having ordinary skill in the art at the time of the [A]pplicant's invention was made to combine Smithies' teaching with Keller and Hess" and "because both references are devoted to e-commerce and transaction document processing", ***does not adequately address the issue of motivation to combine.*** (20 October 2005 Office Action, Page 9). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Hess, Keller, or Smithies*, either individually or in combination.

The Applicant's Claims are Patentable over the Proposed *Hess-Keller-Smithies* Combination

With respect to independent claims 28, 35, and 42 each of these claims includes limitations similar to those discussed above in connection with independent claim 30. Thus, independent claims 28, 35, and 42 are considered patentably distinguishable over the proposed combination of *Hess, Keller, and Smithies* for at least the reasons discussed above in connection with independent claim 30.

With respect to dependent claims 2-11, 13-19, 21-27, 29 31-34, and 36-41: claims 2-11 and 29 depend from independent claim 30; claims 13-19 and 31-34 depend from independent claim 35; and claims 21-27 and 36-41 depend from independent claim 42. As mentioned above, each of independent claims 28, 35, and 42 include limitations similar to those discussed above in connection with independent claim 30. Thus, dependent claims 2-11, 13-19, 21-27, 29 31-34, and 36-41 are considered patentably distinguishable

over the proposed combination of *Hess, Keller, and Smithies* for at least the reasons of depending from an allowable claim and are therefore considered to be in condition for allowance.

For at least the reasons set forth herein, the Applicant submits that claims 2-11, 13-19, and 21-42 are not rendered obvious by the proposed combination of *Hess, Keller, and Smithies*, or in knowledge generally available to those of ordinary skill in the art at the time of the invention. The Applicant further submits that claims 2-11, 13-19, and 21-42 are not rendered obvious by the proposed combination of *Hess, Keller, and Smithies*, or in knowledge generally available to those of ordinary skill in the art at the time of the invention, and are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 2-11, 13-19, and 21-42 under 35 U.S.C. § 103(a) be reconsidered and that claims 2-11, 13-19, and 21-42 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and ***not based on applicant's disclosure***. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

1/20/06
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